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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/234,351	01/20/1999	MARVIN L. WILLIAMS	WILLIAM-2	6210

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EXAMINER

NGUYEN, MAIKHANH

ART UNIT PAPER NUMBER

2176

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/234,351

Applicant(s)

WILLIAMS, MARVIN L.

Examiner

Maikhanh Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6,8-9,11-15,17-18,20-24 and 26-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-6,8-9,11-15,17-18,20-24 and 26-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the following communications: RCE filed 08/26/2004 to the original application filed 01/1999.
2. Claims 2-6, 8-9, 11-15, 17-18, 20-24 and 26-51 are currently pending in this application. Claims 1, 7, 10, 16, 19 and 25 have been canceled. Claims 28-51 have been added. Claims 2-6, 8-10, 11-15, 17-18, 20-24 and 26-27 have been amended. Claims 28, 37 and 43 are independent claims.

Request Continuation for Examination

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/26/2004 has been entered.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 29, 31, 33, 44, 46 and 48 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

5. Specification does not explicitly describe nor is sufficiently clear for one of ordinary skill in art to recognize the following steps as recited in claims 29, 31, 33, 44, 46 and 48:

- the means for displaying a second web page comprise **an actuator** displayed along with the first web page **whose actuation triggers** displaying of the second web page.

- **a first actuator** displayed along with the first web page **whose actuation triggers** displaying of the web page corresponding to the hypertext reference that follows the one hypertext reference in the order, and **a second actuator** displayed along with the first web page **whose actuation triggers** displaying of the web page corresponding to the hypertext reference that precedes the one hypertext reference in the order.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 28, 30, 32, 37-39, 43, 45 and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The languages “*in response to a next command issued by the user while the first web page is displayed and wherein the next command does not identify an electronic mail message or a hypertext reference, displaying a second web page, corresponding to another of the located hypertext references that is next in relation to the one hypertext reference in an order of the located hypertext references predetermined by a preference of the user, without in a meantime displaying the electronic mail message in which the other hypertext reference is located*” (in claims 28, 30, 32, 37-39, 43, 45 and 47) are unclear.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-6, 8-9, 11-15, 17-18 and 20-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Birrell et al.** (U.S. 6,029,192 – filed 03/1997) in view of **Williams** (U.S. 6,151,630 – filed 05/1998).

As to independent claim 37, Birrell teaches an electronic mail program (*e-mail; col.4, lines 21-31*), a method comprising:

- locating hypertext references in a plurality of electronic mail messages (*col.11, lines 54-63*); and

- in response to a first command from a user displaying a first web page corresponding to one of the located hypertext references (*col.11, line 59-col.12, lines 13*)

Birrell does not explicitly teach “in response to a next command issued by the user while the first web page is displayed and wherein the next command does not identify a hypertext reference, displaying a second web page, corresponding to another of the located hypertext references that is next in relation to the one hypertext reference in an order of the located hypertext references predetermined by a preference of the user.”

Williams teaches in response to a next command issued by the user while the first web page is displayed (*col.1, lines 53-58*) and wherein the next command does not identify a hypertext reference, displaying a second web page, corresponding to another of the located hypertext references that is next in relation to the one hypertext reference (*col.1, lines 48-65 and col.2, lines 45-51*) in an order of the located hypertext references predetermined by a preference of the user (*col.3, lines 13-28*).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Williams in the system of Birrell because it would have provided the capability for facilitating browsing through an ordered sequence of a plurality of pages of information in a manner that automatically by passes, skips over, previously-viewed pages in the sequence.

As to dependent claim 38, Birrell teaches displaying the electronic message (*e.g., messages are normally displayed; col.11, lines 54-63*), but does not explicitly teach “in response to another command issued by the user while the first web page is displayed and wherein the other command does not identify a hypertext reference, displaying a third web page

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corresponding to yet another of the located hypertext references that precedes the one hypertext reference in the order.”

Williams teaches in response to another command issued by the user while the first web page is displayed (*col.1, lines 49-65*) and wherein the other command does not identify a hypertext reference, displaying a third web page corresponding to yet another of the located hypertext references that precedes the one hypertext reference in the order (*col.3, lines 26-67*).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Williams in the system of Birrell because it would have provided the capability for facilitating browsing through an ordered sequence of a plurality of pages of information in a manner that automatically by passes, skips over, previously-viewed pages in the sequence.

As to dependent claim 39, it includes the same limitations as in claim 38, and is similarly rejected under the same rationale.

As to dependent claim 40, Birrell teaches in response to displaying the first web page (*col.11, line 59-col.12, lines 13*), but does not explicitly teach “marking all hypertext references corresponding to the first web page as having been accessed.”

Williams teaches marking all hypertext references corresponding to the first web page as having been accessed (*col.1, lines 36-43 / col.6, lines 43-59 and Fig.5*)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Williams in the system of Birrell because it would have provided the capability for indicating to the user that he or she has already view that page.

As to dependent claim 41, Birrell teaches in response to displaying the first web page (*col.11, line 59-col.12, lines 13*), deleting the hypertext reference corresponding to the first web page from the order (*col.14, lines 3-4 and col.15, lines 41-43*).

As to dependent claim 42, Birrell teaches in response to the locating, displaying a list of the electronic mail messages, including displaying in the list each located hypertext reference in association with an identifier of the electronic mail message in which the located hypertext reference is found (*col. 11, line 54-col.12, lines 20*).

As to independent claim 28, the rejection of independent claim 37 above is incorporated herein in full. Additionally, claim 37 further recites “a message organizer the order the located hypertext references in an order predetermined by a preference of a user.”

Birrell teaches a message organizer (*col.4, lines 16-19*), but does not explicitly teach “order the located hypertext references in an order predetermined by a preference of a user.”

Williams teaches order the located hypertext references in an order predetermined by a preference of a user (*col.3, lines 13-28*).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Williams in the system of Birrell because it would have provided the capability for facilitating browsing through an ordered sequence of a plurality of pages of information in a manner that automatically by passes, skips over, previously-viewed pages in the sequence.

As to dependent claim 2, Birrell teaches the message (*col.4, lines 16-19*) organizer further causes the electronic mail program to display a message field containing the hypertext

references and a from field containing the sender associated with each of the hypertext references (*col.8, line 66-col.9, line 2/ col.11, line 54-col.12, line 13*).

As to dependent claim 3, Birrell teaches the electronic mail messages are each selected from the group consisting of: a direct electronic mail message, and a newsgroup posting (*col.1, lines 33-38*).

As to dependent claim 4, Birrell teaches the message organizer (*col.4, lines 16-19*), but *does not* explicitly teach “the hypertext references have associated viewing statues, identically marking viewing statuses of identical ones of the hypertext reference.”

Williams teaches the hypertext references have associated viewing statues, identically marking viewing statuses of identical ones of the hypertext reference (*col.1, lines 36-43; and col.4, lines 33-59*).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Williams in the system of Birrell because it would have provided the capability for facilitating browsing through an ordered sequence of a plurality of pages of information in a manner that automatically by passes, skips over, previously-viewed pages in the sequence.

As to dependent claim 5, Birrell teaches the message organizer orders based on the hypertext references and the sender associated with each of the hypertext references (*col.4, lines 16-24 / col. 11, lines 38-53*).

As to dependent claim 6, Birrell teaches the hypertext references are uniform resource locators (*e.g., URL; col. 12, lines 2-13*).

As to dependent claim 8, Birrell teaches a browser (*e.g., Web browser; col.11, lines 54-63*) and wherein the message organizer is capable of employing the browser to view information associated with the hypertext references (*col.11, line 54-col.12, lines 13*).

As to dependent claim 9, it includes the same limitations as in claim 4, and is similarly rejected the same rationale.

As to dependent claims 11-15, they include the same limitations as in claims 2-6, and are similarly rejected the same rationale.

As to dependent claims 17-18, they include the same limitations as in claims 8-9, and are similarly rejected the same rationale.

As to dependent claims 20-24, they include the same limitations as in claims 2-6, and are similarly rejected the same rationale.

As to dependent claims 26-27, they include the same limitations as in claims 8-9, and are similarly rejected the same rationale.

As to dependent claim 29, Birrell teaches an actuator displayed along with the first web page whose actuation triggers displaying of the second web page (*col.11, lines 54-63*).

As to dependent claim 30, it includes the same limitations as in claim 39, and is similarly rejected the same rationale.

As to dependent claim 31, it includes the same limitations as in claim 29, and is similarly rejected the same rationale.

As to dependent claim 32, it includes the same limitations as in claim 30, and is similarly rejected the same rationale.

As to dependent claim 33, Williams teaches a first actuator displayed along with the first web page whose actuation triggers displaying of the web page corresponding to the hypertext reference that follows the one hypertext reference in the order (*col.11, lines 54-63*) and a second actuator displayed along with the first web page whose actuation triggers displaying of the web page corresponding to the hypertext reference that precedes the one hypertext reference in the order (*col.12, lines 2-20*).

As to dependent claim 34, refer to claim 40 above for rejection.

As to dependent claim 35, it includes the same limitations as in claim 41, and is similarly rejected the same rationale. Additional, claim 35 further recites “the message organizer.”

Birrell teaches the message organizer (e.g., organize mail messages; *col.4, lines 16-19*).

As to dependent claim 36, Birrell teaches responsive to the locating, for displaying a list of the electronic mail messages, including displaying in the list each located hypertext reference in association with an identifier of the electronic mail message in which the located hypertext reference is found (*col.11, line 54-col.12, line 13*).

As to independent claim 43, the rejection of independent claim 37 above is incorporated herein in full. Additionally, claim 37 further recites:

- a message receiver;
- a message transmitter coupled to the message receiver;
- a message composer coupled to the message transmitter; and
- a message store coupled to the message composer

Birrell teaches:

- a message receiver (*the messages were received; col.11, lines 4-38 / the message has been received; col.12, lines 38-44*);

- a message transmitter (*send a message; col.14, lines 50-54*) coupled to the message receiver;

- a message composer (*compose begins a new message; col.14, lines 15-33*) coupled to the message transmitter; and

- a message store (*new messages are stored; col.11, lines 29-38*) coupled to the message composer

As to dependent claims 44-45, they include the same limitations as in claims 29-30, and are similarly rejected the same rationale.

As to dependent claim 46, it includes the same limitations as in claim 29, and is similarly rejected the same rationale.

As to dependent claim 47, it includes the same limitations as in claim 30, and is similarly rejected the same rationale.

As to dependent claims 48-49, they include the same limitations as in claims 33-34, and are similarly rejected the same rationale.

As to dependent claims 50-51, they include the same limitations as in claim 35-36, and is similarly rejected the same rationale.

Response to Arguments

8. Applicant's arguments filed 08/26/2004 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gibson U.S Patent No. 6,209,027 issued: Mar. 27, 2001

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093.

The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on (571) 272-4090.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maikhanh Nguyen
November 12, 2004


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER